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EXAMINER

MAKI, STEVEN D

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RONALD JOHN ROSENBERGER

Appeal 2009-003029
Application 10/822,049
Technology Center 1700

Decided: February 16, 2010

Before BEVERLY A. FRANKLIN, LINDA M. GAUDETTE, and
MICHAEL P. COLAIANNI, *Administrative Patent Judges*.

GAUDETTE, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's decision finally rejecting claims 1, 2, 4-10, 12, 13, 16, and 17 (Final Office Action, mailed Sep. 8, 2006, 1), the only claims pending in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

The invention is directed to a vehicle tire, for example, a rubber automobile tire, wherein the tire is enhanced with a novelty scent or fragrance. (Specification (“Spec.”) 6.) “The novelty scented tire gives off a unique aroma when at rest, or when the tire is in use.” (Spec. 6.) “Friction, heat buildup, and wear due to use [are] effective means of releasing the aroma.” (Spec. 6.) Thus, for example, it is possible for “customized car or motorcycle owners [who] enjoy ‘smoking’ their tires” to produce smoke imbued with a desired scent or aroma. (Spec. 7.) The invention contemplates a wide variety of scents or fragrances, including “new car smell,” “pleasant aromas such as vanilla, lemon, cherry, etc., or even less usual scenting aromas, such as beer, flatulence, or cannabis.” (Spec. 7.) The Specification further states that pheromones may be added to, or in place of the novelty scent or fragrance, for purposes such as “attract[ing] members of a desired gender,” e.g. to “help a young man that ‘smokes’ his tires to be regarded as a heartthrob instead of a jerk, by young women witnessing such behavior.” (Spec. 7-8.)

The Examiner relies on the following evidence to establish unpatentability (Examiner’s Answer (“Ans.”), mailed May 28, 2008, 3-4):

Berliner	5,278,141	Jan. 11, 1994
Downey (CA 958)	CA 547,958	Oct. 29, 1957
Trechot (FR 340)	FR 1,498,340	Sep. 11, 1967
Krieger (DE 356)	DE 2,949,356	Jun. 11, 1981
Antonio GB 584)	GB 2,243,584 A	Jun. 6, 1991
Ameno (JP 908)	JP 11-151908	Jun. 8, 1999
Mellet	WO 01/43958 A1	Jun. 21, 2001
Che (FR 013)	FR 2,800,013	Apr. 27, 2001
Hisa (JP 873)	JP 14114873	Apr. 16, 2002
Jang (KR 611)	KR 10-2004-0029611	Apr. 8, 2004

Appellant requests review of the following grounds of rejection (Appeal Brief (“App. Br.”), filed Mar. 7, 2008, 5)¹:

1. claims 6-9, and 16 under 35 U.S.C. § 112, second paragraph, as indefinite;
2. claims 1, 4-10, 12, 13, 16, and 17 under 35 U.S.C. § 102(b) as anticipated by GB 584;
3. claims 1, 4-10, 12, 13, 16, and 17 under 35 U.S.C. § 103(a) as unpatentable over GB 584 in view of KR 611, JP 873, or DE 356;
4. claims 1, 5-10, 16, and 17 under 35 U.S.C. § 103(a) as unpatentable over JP 873 in view of FR 013, CA 958, or JP 908;
5. claim 2 under 35 U.S.C. § 103(a) as unpatentable over JP 873 in view of FR 013, CA 958, or JP 908, and further in view of Berliner;
6. claims 4 and 13 under 35 U.S.C. § 103(a) as unpatentable over JP 873 in view of FR 013, CA 958, or JP 908, and further in view of FR 340; and
7. claim 12 under 35 U.S.C. § 103(a) as unpatentable over JP 873 in view of FR 013, CA 958, or JP 908, and further in view of Mellet.

Only those arguments actually made by Appellant have been considered in this decision. Arguments which Appellant could have made but chose not to make have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2009). We note that Appellant has not filed a Reply Brief.

¹ For the reason explained by the Examiner (Ans. 3), we do not address Appellant’s request for review of the objection to claim 10 under 37 C.F.R. § 1.75(c). *See* 37 C.F.R. § 41.31(c).

*Ground of Rejection 1: claims 6-9, and 16 under
35 U.S.C. § 112, second paragraph, as indefinite*

Appellant does not dispute the facts and reasons relied on by the Examiner in concluding that claims 6-9 and 16 are indefinite under 35 U.S.C. § 112, second paragraph. (*See* Br. 6 (“Appellant would be willing to [] amend the claims to remove this rejection.”).) Because Appellant has not presented persuasive arguments in support of reversal (*see* Ans. 11), we sustain this ground of rejection.

*Grounds of Rejection 2 and 3: claims 1, 4-10, 12, 13, 16, and 17
under 35 U.S.C. § 102(b) as anticipated by GB 584, and
under 35 U.S.C. § 103(a) as unpatentable over GB 584
in view of KR 611, JP 873, or DE 356*

Appellant does not present separate arguments in support of patentability of any particular claim or claim grouping. (Br. 6-9.²) Therefore, we decide the appeal as to grounds of rejection 2 and 3 on the basis of independent claim 1. 37 C.F.R. § 41.37(c)(1)(vii). Claim 1 is reproduced below (as it appears in the Claims Appendix to the Brief):

1. A vehicle tire, comprising at least one removable insert, o-ring or plug provided in at least one void contained adjacent to the outside surface of at least one of a tread, a belt or a ply of said vehicle tire, said insert, o-ring or plug comprising at least one scent or fragrance that is released when said tire is used in a vehicle for driving, said release of said scent or fragrance due to friction, heat buildup, or wear.

We identify the following issue as dispositive of the appeal as to Grounds of Rejection 2 and 3: has Appellant identified error in the

² *See also*, Br. 5 (expressly stating that all pending claims are argued together).

Examiner's finding that GB 584 discloses all the elements recited in appealed claim 1?

On page 3 of the Answer, the Examiner sets forth detailed factual findings to establish that all the elements of appealed claim 1 can be found in GB 584. Appellant does not dispute these findings. (*Cf.* Br. 6-9.) Rather, Appellant's traversal of the Examiner's anticipation rejection is limited to his contention

that the cited art fails to disclose, teach or suggest the use of an added scent or fragrance compound in a plug or insert that gives off the scent or fragrance when the vehicle tire is used but does not include the use of the scent as a tire wear indicator.

(Br. 7.)

When all the elements of the claimed invention can be found in a prior art reference, either explicitly or inherently, the invention is said to be "anticipated." *In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997). As pointed out by the Examiner, Appellant's argument in support of patentability is based on an unclaimed feature. (Ans. 11-12.) For the reasons stated on pages 11-12 of the Answer, Appellant has not explained why the facts relied on by the Examiner fail to support a finding that GB 584 discloses all of the recited claim 1 limitations. (*Id.*)

Because Appellant has not identified error in the Examiner's finding that GB 584 discloses all the elements of appealed claim 1, we sustain the rejections of claims 1, 4-10, 12, 13, 16, and 17 under 35 U.S.C. § 102(b) as anticipated by GB 584, and under 35 U.S.C. § 103(a) as unpatentable over GB 584 in view of KR 611, JP 873, or DE 356. *See In re May*, 574 F.2d 1082, 1088-89 (C.C.P.A. 1978) ("[L]ack of novelty is the epitome of obviousness.").

Ground of Rejection 4: claims 1, 5-10, 16, and 17 under 35 U.S.C. § 103(a) as unpatentable over JP 873 in view of FR 013, CA 958, or JP 908

Appellant does not present separate arguments in support of patentability of any particular claim or claim grouping. (Br. 9-10; *see supra* note 2.) Therefore, we decide the appeal as to the fourth ground of rejection on the basis of independent claim 1.

We identify the following issues as dispositive of the appeal as to ground of rejection 4: (1) has Appellant identified error in the facts and reasons relied on by the Examiner in concluding that claim 1 would have been obvious? and (2) has Appellant identified error in the Examiner's proposed motivation for combining the references?

On page 6 of the Final and page 8 of the Answer, the Examiner makes detailed factual findings to establish that JP 873 discloses the invention as claimed with the exception of a removable insert. On page 7 of the Final Rejection (Final) and pages 8-9 of the Answer, the Examiner sets forth detailed factual findings to establish that each of the secondary references (FR 013, CA 958 and JP 908) discloses removable inserts.

Appellant does not explicitly disagree with any of these findings, but generally contends that the "invention is not suggested or taught by the cited references, alone or in combination." (Br. 10.)

The Examiner further determined that:

one of ordinary skill in the art would have been motivated to include perfume containing particles in the removable insert of French 013, Canada 958 or Japan 908 so as to obtain the expected benefits of (1) a tread which can emit desired aroma as the tire wears and (2) having part of the tread being removable to change color of the tread (French 013), having

part of the tread replaceable to avoid the cost of replacing the entire tread (Canada 958) or improving the fashionableness of the tire (Japan 908).

(Final 7; Ans. 9.)

Appellant does not explicitly identify error in the above-stated motivation to modify/combine the teachings of the references, but generally contends that “there is no motivation to combine the teachings of the cited references to provide the presently claimed combination.” (Br. 10.)

“During patent examination the PTO bears the initial burden of presenting a prima facie case of unpatentability.” *In re Glaug*, 283 F.3d 1335, 1338 (Fed. Cir. 2002) (citations omitted). A prima facie case of obviousness is established where the Examiner demonstrates that the invention is nothing more than the predictable result of a combination of familiar elements according to known methods *KSR Int’l. Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007).

“For obviousness under § 103, all that is required is a reasonable expectation of success.” *In re O’Farrell*, 853 F.2d 894, 903-04 (Fed. Cir. 1988)(citations omitted). “Obviousness does not require absolute predictability.” *In re Merck & Co.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986).

“As long as some motivation or suggestion to combine the references is provided by the prior art taken as a whole, the law does not require that the references be combined for the reasons contemplated by the inventor.” *In re Beattie*, 974 F.2d 1309, 1312 (Fed. Cir. 1992). As explained by our reviewing court,

Because the desire to enhance commercial opportunities by improving a product or process is universal – and even common-sensical – we have held that there exists in these

situations a motivation to combine prior art references even absent any hint of suggestion in the references themselves. In such situations, the proper question is whether the ordinary artisan possesses knowledge and skills rendering him capable of combining the prior art references.

Dystar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co., 464 F.3d 1356, 1368 (Fed. Cir. 2006).

“[W]here the prior art gives reason or motivation to make the claimed [invention] . . . the burden (and opportunity) then falls on an applicant to rebut that *prima facie* case. Such rebuttal or argument can consist of . . . any other argument or presentation of evidence that is pertinent.” *In re Dillon*, 919 F.2d 688, 692-93 (Fed. Cir. 1990) (*en banc*); *see also, In re Glaug*, 283 F.3d at 1338 (“[W]hen a *prima facie* case is made, the burden shifts to the applicant to come forward with evidence and/or argument supporting patentability.”).

In our view, the Examiner has properly followed the guidelines set forth in *KSR* for establishing a *prima facie* case of obviousness. *See generally*, 550 U.S. 398. Given the Examiner’s detailed findings of fact and statement of motivation to combine the references, Appellant must do more than simply provide general assertions of nonobviousness and lack of motivation to combine in order to identify error in the Examiner’s obviousness determination.

In sum, because Appellant has not identified error (1) in the facts and reasons relied on by the Examiner in concluding that claim 1 would have been obvious or (2) in the Examiner’s proposed motivation for combining the references, we sustain the rejection of claims 1, 5-10, 16, and 17 under

35 U.S.C. § 103(a) as unpatentable over JP 873 in view of FR 013, CA 958, or JP 908.

Grounds of Rejection 5-7: claim 2 under 35 U.S.C. § 103(a) as unpatentable over JP 873 in view of FR 013, CA 958, or JP 908, and further in view of Berliner; Rejection of claims 4 and 13 under 35 U.S.C. § 103(a) as unpatentable over JP 873 in view of FR 013, CA 958, or JP 908, and further in view of FR 340; Rejection of claim 12 under 35 U.S.C. § 103(a) as unpatentable over JP 873 in view of FR 013, CA 958, or JP 908, and further in view of Mellet

On pages 10-11 of the Answer, the Examiner makes factual findings with respect to Berliner, FR 340, and Mellet. The Examiner further explains the motivation for combining each of these references with JP 873 and either FR 013, CA 958, or JP 908 to achieve the inventions recited in claims 2, 4 and 13, and 12.

Appellant's traversal of each of these grounds of rejection is limited to general assertions of nonobviousness and lack of motivation to combine. (See Br. 10-12.)

For the reasons stated above (*see* discussion of Ground of Rejection 4 *supra* pp. 6-8) and in the Answer (Ans. 13-15), Appellant's arguments fail to persuade us of error in the Examiner's obviousness determination.

Therefore, we sustain the rejections of: claim 2 under 35 U.S.C. § 103(a) as unpatentable over JP 873 in view of FR 013, CA 958, or JP 908, and further in view of Berliner; claims 4 and 13 under 35 U.S.C. § 103(a) as unpatentable over JP 873 in view of FR 013, CA 958, or JP 908, and further in view of FR 340; and claim 12 under 35 U.S.C. § 103(a) as unpatentable over JP 873 in view of FR 013, CA 958, or JP 908, and further in view of Mellet.

CONCLUSION

The decision of the Examiner rejecting claims 1, 2, 4-10, 12, 13, 16, and 17 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

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